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NOVAK DRUCE
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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON TX 77002

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OFFICE OF PETITIONS

In re Application of :
Danielsson, et al. :
Application No. 09/683,769 : **DECISION**
Filed: 12 February, 2002 :
Attorney Docket No. 6730.008.NPUS01 :

This is a decision on the petition, filed on 24 July, 2009, to revive under 37 C.F.R. §1.137(b) and alleging abandonment due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II).

BACKGROUND

The record reflects that:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 20 October, 2003, with reply due absent an extension of time on or before 20 January, 2004.

The application went abandoned after midnight 20 January, 2004.

The Office mailed the Notice of Abandonment on 23 July, 2004.

On 21 December, 2005, more than 23 months after abandonment and nearly 17 months after notice thereof, Petitioner filed via FAX (apparently under 37 C.F.R. §1.181) copies of a receipt card and claims, with no discussion of the facts and no explanation for the extended delays—Petitioner appears to have ignored the requirements set forth at 37 C.F.R. §1.181 and MPEP §711.03(c) regarding matters such as this for the filing of a petition within two months of the act complained of—a call was placed on 9 June, 2006, to Petitioner's offices to inquire about the matter, however, upon reaching the telephone number on the papers submitted by Petitioner in December 2005, the persons answering the call indicated that Petitioner had not been with the office for more than a year. Thus, it was not possible to inquire of the matter with Petitioner, and the petition under 37 C.F.R. §1.181 was dismissed on 12 June, 2006, and Petitioner was given two months to reply.

On 10 October, 2007, Petitioner filed a petition (under 37 C.F.R. §1.137(b)) with fee, another copy of a receipt card and of an amendment and claims, set forth the regulatory statement of unintentional delay, but provided absolutely no explanation of the delay between the original due date of the reply to the non-final Office action mailed on 20 January, 2004, and the filing of papers the Office generously construed as a petition on 21 December, 2005; or of the delay between the decision mailed on 12 June, 2006, and the filing of the petition under 37 C.F.R. §1.137(b) 16 months later on 10 October, 2007. As indicated in the petition decision of March 2008, three periods are considered in the evaluation of a petition to revive, to wit: the delay in the reply that originally resulted in the abandonment; the delay in filing of an initial petition to return the application to pending status; and the delay in the filing of a grantable petition to revive the application. Because Petitioner little if any showing in this regard, the petition was dismissed on 17 March, 2008, and again Petitioner was given two (2) months within which to reply.

More than 7 months later, on 28 October, 2008 (over a 17 October, 2008, certificate of mailing), Petitioner filed a petition with fee (charged). However, all that appeared was a title page (styled as "Renewed Petition Under 37 C.F.R. [§]1.137(b)") and a second but unnumbered page authorizing the charge of fees for a five- (5-) month extension of time and request with fee (not previously but now charged). Petitioner provided no substantive content to address the petition, and because the pages are unnumbered it is not possible to determine whether content might have been lost, not included or otherwise misplaced in Petitioner's process of submission. The Office was compelled to address the petition as it appears in the record, and it appeared at that time that Petitioner provided no satisfactory showing as to the unintentional nature of the delay in the period in question and as requested previously. Petitioner was instructed to provide a satisfactory showing as to the unintentional nature of the delay in the three period itemized above (as requested previously); and satisfy himself that a proper reply to the 20 October, 2003, non-final Office action has been submitted. The petition was dismissed on 15 December, 2008.

Again following seven months' passage, on 24 July, 2009, Petitioner filed a petition and this time presented four page discussion and certain documents—and with those materials asserted that although:

- the application was abandoned nearly two years (from actual abandonment in January 2004) and some seventeen (17) months after Notice thereof (July 2004) before the first papers were filed—and even then no petition was filed consistent with the rule, only sketchy papers that the Office out of courtesy to Petitioner considered as a petition; and
- Petitioner delayed sixteen (16) months (June 2006 – October 2007) between the first decision and the second petition, then seven (7) months between the second decision and third petition (March 2008 – October 2008), and finally seven (7) months December 2008 – July 2009) between the third decision and the fourth petition,

the Office, nonetheless, should withdraw the holding of abandonment in the instant matter. The regulations at 37 C.F.R. §1.181 expressly provide that one who seeks relief pursuant to the rule is to do so within two (2) months of the action (abandonment) complained of.¹ Because Petitioner failed to comply with the provisions of the rule, the relief which the rule might have provided had it been timely invoked was not available to Petitioner. However, Petitioner not only failed to be prompt in his response, but delayed a total of thirty months between decisions and successive petitions. In any case Petitioner finally, if grudgingly, provided the petition, fee, reply and statement/showing of unintentional delay required pursuant to the regulations at 37 C.F.R. §1.137(b) and request and fee (charged) for extension of time.

The record (including the petitions filed on 21 December, 2005, on 10 October, 2007, on 28 October, 2008, and on 24 July, 2009) does not necessitate a finding that the delay between midnight 20 January, 2004 (date of abandonment), and 24 July, 2009 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioners (Danielsson, et al.) and their Counsel Tracy W. Druce Reg. No. 35,493) when accepting Petitioners' representation that the delay in filing the response was unintentional.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

¹ Petitioner now indicates that: he left the law firm of Howrey Simon Arnold & White (Washington, DC) the original correspondence address of record, "[i]n the first half of 2004; and thereafter he used a McLean, Virginia, address as correspondence address of record, which is the period in which the Notice of Abandonment was mailed (July 2004), and which Notice Petitioner states he did not receive.

² See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴ The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁵))

As to Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is granted.

The instant application is released to the Technology Center/AU 2855 for further processing in due course.

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

⁴ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁶ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.